

## REMARKS

Claims 16-25 and 27-30 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wireless Application Protocol, MMS Encapsulated Protocol, Version 05-Jan-2002 (hereinafter "WAP") in view of Ratschunas et al. (WO 01/28171 A1); and claim 26 has been rejected under 35 U.S.C. §103(a) as being unpatentable over WAP in view of Ratschunas et al. (WO 01/28171 A1) and Aho (US Patent Pub. 2001/0010685). The rejections are respectfully traversed as moot in view of the newly added claims. No new matter has been added.

The focus of Applicants newly admitted claims centers on the limitation "signaling, upon non-delivery of the data to the second communications unit, with the transmission status message, whether the data could not be delivered to the second communications unit or whether the data could have been delivered, but were not received by the second communications unit", which is required by claim 31 (and a similar limitation is also found in claim 38). Applicants submit that this limitation is not disclosed by the prior art of record.

The Examiner previously relied on the Ratschunas reference as disclosing the "non-deliverability of data to the second communications unit" limitation as well as the limitations referencing "the non-deliverability of the data sent applied if one of the correct receipt of the data send...is not acknowledged by the scone communications unit..." (See, page 3, first and second paragraphs of Final Office Action, extending to page 4, first paragraph). Applicants maintain the argument that Ratschunas teaches that the transmitter inserts a receiving condition into a message, and the receiver can only receive the message if the receiving condition is met (see Abstract, page 3, lines 6-14). The purpose of this arrangement is to reduce network load by tailoring messages only to recipients that meet a specific condition (e.g., location), where unnecessary messages are not transmitted (page 3, lines 28-34). However, Ratschunas teaches that the "condition" *is one that must be met before the message is even transmitted*. For example, using the location of the device, Ratschunas teaches that the Mobile Location Center (MLC 5) determines the location of the recipient, and if the recipient is not in the intended location, the message is not transmitted (Fig. 2; page 10, line 24 - page 11, line 9). In the alternate embodiment described on page 12, line 22 - page 13, line 11, the message is transmitted

to a multimedia service center (MMSC 2), which then determines whether or not the condition is met.

In either case, Ratschunas clearly fails to disclose in the event of non-delivery due to non-received data be and a determination as to whether the data could have or could not have been delivered to the second communications unit, as required by the claimed invention. The Examiner comments, with reference to Figure 2, steps S6 and S7, that a message is sent to the originator that the MS is not reachable (i.e. read as item of information concerning the non-deliverability of the transmitted data), and that it therefore broadly teaches when the data is not delivered to the second communications unit, the transmission status message indicates that the data was not delivered to the second communications unit. While Applicants do not admit that this is indeed the case, the reference clearly fails to disclose a determination as to whether the data could have or could not have been delivered. Nor does the Examiner's reference to steps S5 and S6 read on this limitation. Rather, the reference, according to the Examiner, shows that when a receiving condition is not met, a message indicates that the MS is inactive or busy. However, there is no determination as to whether the data could have been delivered or not.

Additionally, there is no apparent reason why one skilled in the art would combine the WAP document and the Ratschunas reference in the manner suggested in the Office Action. Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary consideration (e.g., the problem solved). *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ2d 459, 467 (1966). “[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) (“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”). The analysis

supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements” in the manner claimed. *KSR*, 127 S. Ct. at 1732, 82 USPQ2d at 1389.

Applicant respectfully submits that the Office Action has improperly piecemealed individual features from multiple references to arrive at the present rejection. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 127 S. Ct. at 1732. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments relying on *ex post* reasoning.” *KSR* 127 S. Ct. at 1740.

Regarding WAP, the sending status is already known. For example, in section 7.2.20, the “Response-Status” field is described within the “M-Send.conf” message (see section 6.1.2, page 14). This configuration is acknowledged in FIG. 2 and related text in the present specification (page 13, line 8 - page 14, line 30), which is believed to be consistent with the disclosure in the WAP document. As was explained previously, the “M-Send.req” message provides error and status information with regard to the sending of the MMS message (see also 7.2.23: “retrieved”, “rejected”, “deferred”, “unrecognized”, “expired.”). Since the WAP document already provides the statuses of the sent messages, there is no reason to modify the reference in the manner suggested, absent hindsight reconstruction that relied on the Applicant’s disclosure. For at least these reasons, Applicant submits the rejection is improper and should be withdrawn.

In view of the above, Applicants submit that this application is in condition for allowance. An indication of the same is solicited.

The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing, referencing Attorney Docket No. 112740-1015.

Respectfully submitted,  
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